

**REMARKS**

The Office Action of January 10, 2007, has been received and reviewed. Claims 1-10 and 13 are currently pending in the application. Claim 13 was previously withdrawn from consideration. Claims 1-10 are under consideration. Claims 1-10 stand rejected. Claims 11 and 12 are cancelled herein. Claims 1 and 3-6 are amended herein. All amendments and claim cancellations are made without prejudice or disclaimer. No new matter has been presented. Reconsideration is respectfully requested.

**Priority Documents**

The Examiner indicates that certified copies of PCT/EP02/1188 and EPO 01203760.2 have not yet been provided to The Office. Applicants respectfully submit that the certified copies of the priority documents have been ordered and will be provided to The Office as soon as possible.

**Objections to the Specification**

The Specification stands objected to as improperly indicating the location of the diagram of locus X2. Applicants note that appropriate correction has been made.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite. Applicants note that the rejections of claims 11 and 12 are moot as those claims have been cancelled herein. Applicants respectfully traverse the remaining rejections as hereinafter set forth.

**“Efficient”**

Claims 1 stands rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite for the recitation of “efficient.” Office Action mailed January 10, 2007, at page 4. Applicants respectfully traverse the rejection as hereinafter set forth.

Although the applicants do not agree that any of the claims are indefinite, to expedite

prosecution, claim 1 has been amended herein. Specifically, claim 1 has been amended to no longer recite the term “efficient.” As such, applicants respectfully submit that claim 1 can no longer remain rejected as being indefinite for the recitation of “efficient.” Consequently, applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, and reconsideration of same.

“The recombinant gene comprises a region homologous with the silenced locus”

Claims 1 stands rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite for the recitation of “the recombinant gene comprises a region homologous with the silenced locus.” Office Action mailed January 10, 2007, at page 4. Applicants respectfully traverse the rejection as hereinafter set forth.

Although the applicants do not agree that any of the claims are indefinite, to expedite prosecution, claim 1 has been amended herein. Specifically, claim 1 has been amended to recite “the recombinant gene comprises a region of at least 23 contiguous nucleotides that are at least 60% homologous with the silenced locus.” Basis for the amendment can be found through out the Specification and more specifically at ¶¶ [0005] and [0010]. As such, applicants respectfully submit that claim 1 can no longer remain rejected as being indefinite for the recitation of “the recombinant gene comprises a region homologous with the silenced locus.” Consequently, applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, and reconsideration of same.

“The target gene has homology with the recombinant gene”

Claims 1 stands rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite for the recitation of “the target gene has homology with the recombinant gene.” Office Action mailed January 10, 2007, at page 4. Applicants respectfully traverse the rejection as hereinafter set forth.

Although the applicants do not agree that any of the claims are indefinite, to expedite prosecution, claim 1 has been amended herein. Specifically, claim 1 has been amended to recite “the target gene comprises a region of at least 23 contiguous nucleotides that are at least 60%

homologous with the recombinant gene.” Basis for the amendment can be found through out the Specification and more specifically at ¶¶ [0005] and [0010]. As such, applicants respectfully submit that claim 1 can no longer remain rejected as being indefinite for the recitation of “the target gene has homology with the recombinant gene.” Consequently, applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, and reconsideration of same.

Essential element

Claims 1 stands rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite for failing to recite an essential element. Specifically, it was asserted that claim 1 fails to “indicate that the recombinant gene comprises a region identical to a region of the target gene.” Applicants respectfully traverse the rejection as hereinafter set forth.

Applicants note that the Specification, as read by one of ordinary skill in the art, does not require that the recombinant gene comprise a region identical to a region of the target gene. Specifically, ¶ [0010] of the Specification informs that “or has a region of overall homology of more than 60, 70, 80, 90, 95 or even more than 99%” (emphasis added). As such, applicants respectfully submit that an identical region is not required, only a region of overall homology of at least 60%. Consequently, applicants respectfully submit that claim 1 should not be considered as failing to recite an essential step regarding an “identical region.”

In view of the foregoing, applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, and reconsideration of same.

“Of the hosts”

Claims 3-6 stand rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite for the recitation of “of the hosts.” Office Action mailed January 10, 2007, at page 4. Applicants respectfully traverse the rejections as hereinafter set forth.

Although the applicants do not agree that any of the claims are indefinite, to expedite prosecution, claims 3-6 have been amended herein. Specifically, claims 3 and 4 have been amended to recite “obtained more than 95% of the time in the host” and claims 5 and 6 have

been amended to recite “obtained more than 85% of the time in the host.” As such, applicants respectfully submit that claims 3-6 can no longer remain rejected as being indefinite for the recitation of “of the hosts.” Consequently, applicants respectfully request the withdrawal of the rejection of claims 3-6 under 35 U.S.C. § 112, second paragraph, and reconsideration of same.

“To obtain high throughput gene silencing”

Claims 11 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite for the recitation of “to obtain high throughput gene silencing.” The rejections are moot as claims 11 and 12 are cancelled herein.

**Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 1-12 stand rejected under 35 U.S.C. § 112, first paragraph, as assertedly failing to comply with the enablement requirement. Specifically, it was asserted that “claim 1 omits [an] essential element [to wit:] the recombinant gene also comprises a region of the coding sequence of the target gene, operably linked to a 5’ or 3’ untranslated region that is also operably linked to the coding sequence in construct X, which induces silencing of the initially silenced locus in the host plant.” Office action mailed January 10, 2007, at page 7. It was further asserted that “the specification indicates that the locus in RNA-silenced [but this does not appear in the claim]. *Id.* Applicants note that the rejections of claims 11 and 12 are moot as those claims are cancelled herein. Applicants respectfully traverse the remaining rejections as hereinafter set forth.

Applicants respectfully submit that the claims do not omit an essential element. Applicants note that requirement that the recombinant gene comprise a 5’ or a 3’ untranslated region is defined as optional in the specification. The Specification notes at ¶ [0010] that “[a] non-limiting example of a recombinant gene construct is a construct wherein the coding region of a gene is operably linked to a 5’ untranslated region and/or to a 3’ untranslated region of one or more other genes, alternatively the 5’ or 3’ untranslated region is an artificial sequence.” Thus, it is clear from the Specification that a 5’ or a 3’ untranslated region in the recombinant gene is optional and thus not essential.

Further, although the applicants do not agree that any of the claims are not enabled, to

expedite prosecution, claim 1 has been amended herein. Specifically, claim 1 has been amended to recite “comprising an RNA-silenced locus.” As such, applicants respectfully submit that claim 1 can no longer stand rejected for the failure to indicate the type of effecting the locus in the host.

For at least the foregoing reasons, applicants respectfully submit that claim 1, as amended, is enabled. Consequently, applicants respectfully request the withdrawal of the rejections of claim 1 under 35 U.S.C. § 112, first paragraph, and reconsideration of same.

In addition, claims 2-10 were rejected as being depending from an non-enabled base claim (claim 1). As claim 1 is enabled, applicants respectfully submit that claims 2-10 can no longer be rejected as unenabled for depending from claim 1. Consequently, applicants respectfully request the withdrawal of the rejections of claims 2-10 under 35 U.S.C. § 112, first paragraph, and reconsideration of same.

### **CONCLUSION**

In light of the above amendments and remarks, applicants respectfully request reconsideration of the application. If questions remain after consideration of the foregoing, or if the Office should determine that there are additional issues which might be resolved by a telephone conference, the Office is kindly requested to contact applicants’ attorney at the address or telephone number given herein.

**Attorney Docket No.: 2676-6388US**

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Dan J. Morath', with a long horizontal flourish extending to the right.

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